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10/712,232	11/12/2003	Marko Torma	KOLS.061PA	9486
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EXAMINER				
BIAGINI CHRISTOPHER D				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/712,232

Applicant(s)

TORMA, MARKO

Examiner

Christopher Biagini

Art Unit

2442

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 29 October 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments regarding the terms "sync server" and "client" have been fully considered and are persuasive. Accordingly, the terms will be given their broadest reasonable interpretation.

Applicant's arguments with respect to the rejections of claims 16 and 20 under 35 USC 101 have been fully considered but are not persuasive. As described below, the new language of the claims may be construed as encompassing data on a transmission signal, which is not a "process, machine, manufacture, or composition of matter" within the meaning of 35 USC 101.

Applicant's arguments with respect to the rejections under 35 USC 103(a) have been fully considered but are not persuasive.

Regarding the argument that "Hillyard also does not teach or suggest storage/use of role information on a synchronization device," the Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hillyard explicitly teaches at least one benefit of the combination. The modification allows devices whose interactions require client/server roles to communicate without needing to be pre-configured for those roles beforehand (see [0013]-[0014]).

In response to applicant's argument that Hillyard is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Hillyard is reasonably pertinent to the particular problem with which the applicant was concerned; namely, allowing devices whose interactions require client/server roles to communicate without needing to be pre-configured for those roles beforehand (see Hillyard, [0013]-[0014] and the instant specification, [0005]-[0006]).

Finally, regarding the argument that the results of the combination would not have been predictable to one of ordinary skill in the art, the Examiner respectfully disagrees. The teachings of Hillyard describe a method of negotiating roles between devices, and are broadly applicable to many methods of communication that make use of client/server roles. As the electronic arts generally carry a high level of predictability, one of ordinary skill would recognize that using the series of messages described by Hillyard in connection with the system described by the SyncML specification would achieve the predictable result of allowing the devices to negotiate roles and communicate without needing to be pre-configured for those roles beforehand.

Regarding the argument that the assertion of Official Notice was improper, the Examiner respectfully disagrees. As documentary evidence, the Examiner supplies US Publication 2001/0056442 by Dresevic et al. in accordance with MPEP 2144.03. Dresevic et al. show assigning a default value to a setting, and not storing information if the default value is set (see [0107]).

Regarding the arguments that the references relied upon in the rejection of various dependent claims “further do not teach the asserted limitations,” the arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Regarding the argument that Hawkins et al. do not teach that role information is application-specific such that separate role information is stored for each application or application profile, the Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 16 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are directed to a “computer readable medium encoded with a computer program,” but may be reasonably construed to encompass data on a transmission signal. For example, paragraph [0015] of the specification describes that the computer program may be encoded in a signal for transmission over a computer network. Signals transmitted over a network are not a “process, machine, manufacture, or composition of matter” within the meaning of 35 USC 101. See MPEP 2106.01.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 8-11, 13, 15-20, 22, 23, 25, 26, and 30-32 are rejected under 35 U.S.C.

103(a) as being unpatentable over the SyncML Sync Protocol Specification, version 1.0 (hereinafter “the SyncML specification”) in view of Hillyard (US Publication No. 2003/0027526).

Regarding claim 1, the SyncML specification shows a method comprising: establishing a first synchronization session (comprising a SyncML session: see section 4 on page 25) between a first synchronization device (comprising a mobile phone) and a second synchronization device (comprising a server: see section 1.2 on page 7).

The SyncML specification does not show:

- defining automatically based on the first synchronization session and storing role information on the first synchronization device, which indicates whether the first synchronization device should serve as a client or a sync server in at least one subsequent synchronization session,
- checking said role information for the first synchronization device in response to a need for initiating a second synchronization session between the first synchronization device and the second synchronization device, and
- initiating the second synchronization session from the first synchronization device in accordance with said role information.

Hillyard shows:

- defining automatically based on a first session (comprising the session which first establishes a link) and storing role information (comprising client/server role information: see paragraph [0039] and [0057]-[0058]) on a first device, which indicates whether the first device should serve as a client or a server in at least one subsequent session (see paragraph [0054]),
- checking said role information for the first device in response to a need for initiating a second session between the first device and the second device (comprising determining if role information is stored and the nature of the role information: see paragraph [0055]), and
- initiating the second session from the first device in accordance with said role information (see paragraph [0055]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system described in the SyncML specification to use the client/server negotiation taught by Hillyard. Such an arrangement would allow SyncML devices that are peers (that is, devices for which there are no clear, pre-configurable choices for client and server) to successfully connect. See Hillyard, paragraphs [0013]-[0014].

Regarding claim 3, the combination further shows wherein a client initialization message for initiating the first synchronization session is transmitted from the first synchronization device to the second synchronization device (comprising client inquiries, which are sent periodically: see paragraphs [0013] and [0056]), and:

- an acknowledgement is received from the second synchronization device (comprising an inquiry response: see step 718 and [0057]),
- in response to receiving the acknowledgement, synchronization client is stored during the role information storing step for the first synchronization device (see step 728 and [0057]).

Regarding claim 4, the combination further shows wherein the role information is associated with the second synchronization device on the basis of the identifier (comprising the address) of the second synchronization device (see paragraph [0039]), and

the role information associated with the identifier of the second synchronization device is searched from the stored role information in the first synchronization device in response to a need to initiate a second synchronization session with the second synchronization device (see paragraph [0054]).

Regarding claim 8, the combination further shows wherein storing mapping information describing the sameness of data items only on the device, the role of which is synchronization server (see the SyncML specification, section 2.3 on page 12).

Regarding claim 9, the combination further shows wherein the data being synchronized is user data (comprising a calendar: see the SyncML specification, section 2.6.2 on page 14).

Regarding claim 10, the combination further shows wherein the first synchronization device and the second synchronization device support the SyncML standard (see the SyncML specification, section 1.2 on page 7).

Regarding claim 17, the combination further shows wherein a role is selected for the first synchronization device for the second synchronization session on the basis of said role information; and the second synchronization session is initiated from the first synchronization device in accordance with the selected role (see Hillyard, paragraph [0014]).

Claims 11, 13, 16, and 23 correspond to claim 1 and are rejected for the reasons provided above.

Claims 15, 18-20, 22, 23, 25, 26, 30, and 31 correspond to claims 3, 4, 6, 8, 9, 10, and 17 and are rejected for the reasons provided above.

Regarding claim 32, the combination shows the limitations of claim 23 as described above, and further shows wherein the apparatus is a mobile station (comprising a mobile phone: see section 1.2 on page 7 of the SyncML specification).

Claims 2, 14, 21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the SyncML specification in view of Hillyard (US Publication No. 2003/0027526), and further in view of Wallbeck.

The combination further shows:

- wherein a client initialization message for initiating the first synchronization session is transmitted from the first synchronization device to the second synchronization device (comprising client inquiries, which are sent periodically: see Hillyard, paragraphs [0013] and [0056]);
- that errors can occur during the notification process (see Hillyard, step 720 in Fig. 7 and paragraph [0058]),
- receiving error messages when errors occur during the notification process (see the SyncML specification, item 2 on page 29),
- when establishing a server role, a server initialization message is transmitted from the first synchronization device to the second synchronization device (comprising a response to inquiry: see paragraphs [0047] and [0058]; and
- synchronization server is stored during the role information storing step as the role information for the first synchronization device (see step 740 and paragraph [0058])

The combination does not show that a server role is established upon an error. Rather, in the proposed combination, the negotiation process merely restarts (see Hillyard, Fig. 7).

Wallbeck shows establishing a server role upon an error (the error comprising that another device will not assume the necessary server role in a communication session: see paragraph [0026]). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the system described in the SyncML protocol to have the first

device immediately assume a server role in order to save time that would otherwise be wasted on restarting the negotiation process.

Claims 5 and 27 are rejected under 35 USC 103(a) as being unpatentable over the SyncML specification in view of Hillyard (US Publication No. 2003/0027526), and further in view of Hawkins et al. (US Patent No. 5,884,323, hereinafter "Hawkins").

The combination shows the limitations of claims 1 and 23 as described above, but does not show wherein said role information is application-specific so that separate role information is stored in the device for each application and/or application profile in the device.

Hawkins shows storing application-specific synchronization information so that separate role information is stored in a device for each application (comprising maintaining separate conduit libraries for separate applications: see col. 3, lines 5-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the system described in the SyncML protocol with the application-specific synchronization information taught by Hawkins in order to prevent errors in one application's session from impacting another application's session.

Claims 6 and 28 are rejected under 35 USC 103(a) as being unpatentable over the SyncML specification in view of Hillyard (US Publication No. 2003/0027526), and further in view of Dresevic (US Pub. No. 2001/0056442).

The combination shows the limitations of claims 1 and 23 as described above, but does not show wherein the default value of said role information is synchronization client, and the role information is not stored if synchronization client is defined as the role of the device.

Drešević shows assigning a default values to a setting, and not storing information if the default value is set (see [0107]). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the system described in the SyncML specification to not store role information if synchronization client is defined as the role of the device in order to conserve memory in the device (see Drešević, [0107]).

Claims 7, 12, and 29 are rejected under 35 USC 103(a) as being unpatentable over the SyncML specification in view of Hillyard (US Publication No. 2003/0027526), and further in view of Flanagan et al. (US Patent No. 6,272,545, hereinafter “Flanagan”).

The combination shows the limitations of claims 1, 11, and 23 as described above, but does not show wherein said role information is stored in a third device that is other than said first or second device.

Flanagan shows storing role information on a third device that is other than a first or second synchronization device (see col. 3, line 54-61).

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the system described in the SyncML specification with the off-device storage taught by Flanagan in order to relieve individual devices of the burden of storing role information.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Biagini whose telephone number is (571) 272-9743. The examiner can normally be reached on weekdays from 8:30 AM to 5:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew Caldwell/
Supervisory Patent Examiner, Art Unit
2442

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